

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-2, 4-30 and 35 are presently active in this case. The present Amendment amends Claim 1 without introducing any new matter or raising new issues, and cancels Claim 36 without prejudice or disclaimer.

In the outstanding Office Action, Claims 1-11, 15-17 and 22-30 were rejected under 35 U.S.C. §103(a) as unpatentable over Chapman et al. (U.S. Patent No. 6,522,421, herein “Chapman”) in view of Shen (U.S. Patent Publication No. 2003/0187951). Claims 12-14 and 18-21 were rejected under 35 U.S.C. §103(a) as unpatentable over Chapman and Shen and further view of Weiser (U.S. Patent No. 5,920,404).

In response to the rejection of Claims 1-11, 15-17 and 22-30 under 35 U.S.C. §103(a), Claim 1 is amended to recite all the features of dependent Claim 36. Since dependent Claim 36 was considered by the outstanding Office Action, it is respectfully submitted that the present amendment to Claim 1 does not raise new issues requiring further search and/or consideration. Claim 1 now recites “the communication unit being connected to the internet and configured to receive the email from the internet.” Consequently, dependent Claim 36 is cancelled.

In light of the amendments to independent Claim 1, Applicant respectfully requests reconsideration of this rejection and traverses the rejection, as discussed next.

Briefly recapitulating, Claim 1 relates to an apparatus, including, *inter alia*, a ***communication unit configured to receive email through a communication line from a remote site***, the email having been sent by a user and including a first identifier identifying the user and data, ***the communication unit being connected to the internet and configured to receive the email from the internet***; an accumulation unit configured to store therein the

data; a printout unit; an input unit configured to receive a second identifier entered by the user through direct operation thereof at a local site where the apparatus is installed; and a control unit configured to control said printout unit to print the data corresponding to the first identifier at the local site by reading the data from the accumulation unit if the second identifier matches the first identifier.

As explained in Applicant's specification at page 3, lines 14-17, Applicant's invention improves upon background data-output apparatuses, since it can remotely output data *received via email* in an environment suitable for the use of a large number of users.

Turning now to the applied references, Chapman describes a method and apparatus for automatically communicating status information regarding a document production job, wherein an E-mail address is embedded in the application file relating to the party designated to receive the status information.¹ However, Chapman fails to teach or suggest a communication unit configured to *receive an email* through a communication line from a remote site, the email having been sent by a user, wherein the communication unit being connected to the internet and configured *to receive the email from the internet*. To the contrary, Chapman explicitly teaches that the method only involves *embedding email information* within an application file by a word processor, and that the printer can interpret the email information.² In Chapman, the data with the email information is provided *by a normal printer network*, and not *via email*. Chapman does *not* receive an e-mail from a remote site and also does not receive the email from the internet, as recited in Claim 1. Chapman further shows in Figure 2 that in step 42 a file with embedded email information is sent to the printer 15.³

¹ See Chapman in the Abstract.

² See Chapman at column 1, lines 65-67 and in Claim 1.

³ See Chapman in Figure 2 and at column 3, lines 14-20.

The outstanding Office Action rejects the features of dependent Claim 36, now incorporated into independent Claim 1, by pointing to column 3, lines 45-55 of Chapman, and by asserting that Chapman teaches the Claim 36 features in these passages. Applicant respectfully disagrees, as next discussed.

In Chapman, a file having an embedded email address is analyzed,⁴ by “recognizing E-mail addresses contained within the application file,”⁵ and subsequently, *status information is emailed* to the extracted email addresses, so that the person who submitted the print job knows when the job is completed,⁶ by “sending an E-mail message from the printing system to the computational element relative to the status of the document reproduction job.”⁷ As a fact, Chapman is silent on *receiving an E-mail* through the internet.

Accordingly, creating a file with embedded email information and *sending* a confirmation email on the print job to the user, as taught by Chapman, *is not receiving an email* to a communication unit a communication line from a remote site, the email having been sent by a user, the communication unit being connected to the internet and configured to receive the email from the internet, as recited in amended Claim 1. Chapman is silent to any way for a printer to receive an email from the internet, and Chapman is merely able to *send out an E-mail* to an E-mail address extracted from the file, to deliver status information.⁸

The outstanding Office Action further argues that Chapman teaches the features regarding receiving an email, as recited in Applicant’s Claim 1, by pointing out to the definition of “e-mail” in Webopedia.com, but the outstanding Office Action only cites a small part of the definition given for the term “e-mail,” without quoting the entire contents of the definition.⁹ For example, Webopedia.com also explains that “[y]ou then send the

⁴ See Chapman in Figure 2, steps 47 and 48.

⁵ See Chapman, in Claim 1, lines 9-12.

⁶ See Chapman in Figure 2, step 49, and at column 3, lines 33-60.

⁷ See Chapman, in Claim 1, lines 31-33.

⁸ See Chapman at column 3, lines 40-42.

⁹ See the outstanding Office Action from page 16, lines 1-5.

message to the recipient by specifying the recipient's email address," and "[s]ent messages are stored in electronic mailboxes until the recipient fetches them."

However, it seems that Chapman's application file with embedded email address is created by a word processor.¹⁰ Therefore, no *recipient's email* address is ever specified. There is also no E-mail mailbox that has previously received the e-mail. Accordingly, in light of the full definition of the term "e-mail" by webopedia.com, Chapman's application file with an embedded e-mail address does *not* read on the definition of e-mail in Claim 1, and in light of Applicant's specification, to recite "a communication unit configured to receive an email through a communication line from a remote site ... the communication unit being connected to the internet and configured to receive the email from the internet," as recited in amended independent Claim 1.

Such extension of the definition of E-mail beyond Chapman's teachings by the outstanding Office Action is against established case law. Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999) and MPEP §2173.05(a).

The secondary reference Shen, used by the outstanding Office Action to form the obviousness-type rejection, does not remedy the deficiencies of Chapman. Shen describes a system usable to print a document, wherein the system includes receiving an email address and a password corresponding to the email addresses' account.¹¹ Shen further explains that the system opens the email account based on that information and can select a document from

¹⁰ See Chapman at column 3, lines 2-6, and in Figure 2, step 40.

¹¹ See Shen in the Abstract and in Figure 6.

a list of documents stored therein for printing purposes.¹² Accordingly, Shen also fails to teach or suggest the communication unit receiving an email through a communication line from a remote site by the internet, the email having been sent by a user.

Therefore, even if the combination of Chapman and Shen is assumed to be proper, the combination fails to teach every element of independent Claim 1. Accordingly, Applicant respectfully traverses, and requests reconsideration of, this rejection based on these patents.¹³

Since the reference Weiser also fails to teach or suggest all the features of independent Claim 1, Applicant respectfully submits that the rejection of Claims 12-14 and 18-21 is also believed to be overcome.

The present amendment is submitted in accordance with the provisions of 37 C.F.R. §1.116, which after Final Rejection permits entry of amendments placing the claims in better form for consideration on appeal. As the present amendment is believed to overcome outstanding rejections under 35 U.S.C. §103, the present amendment places the application in better form for consideration on appeal. In addition, the present amendment is not believed to raise new issues because the changes to Claim 1 merely recite features previously introduced in dependent Claim 36, that directly depended from Claim 1. It is therefore respectfully requested that 37 C.F.R. §1.116 be liberally construed, and that the present amendment be entered.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-2, 4-30 and 35 is earnestly solicited.

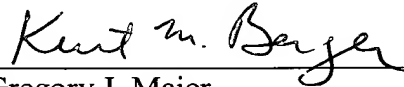
¹² See Shen in the Abstract and at page 3, paragraph 45.

¹³ See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

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